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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/625,148 07/25/00 MIYAMOTO Y OPS CASE 498

IM52/0913
FLYNN THIEL BOUTELL & TANIS PC
2026 RAMBLING ROAD
KALAMAZOO MI 49008-1699

EXAMINER

HOWARD, J

ART UNIT

PAPER NUMBER

1764

DATE MAILED:

09/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Applicant(s)

09/625,148

Applicant(s)

MIYAMOTO ET AL.

Examiner

Jacqueline V. Howard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 to 6 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 6, 8 to 12, 23 and 25 of copending Application No. 09/349,465. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons of record set forth in the Office Action dated 3/14/01.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 to 6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morway et al (2,739,127) combined with Doner et al (5,763,370) or Tanaka et al (5,858,931) for the reasons of record as fully set forth in the Office Action dated 3/14/01.

Applicant's arguments filed June 18, 2001 have been fully considered but they are not persuasive. Applicants traverse the obviousness-type double patenting rejection on the basis that the '465 reference does not specifically disclose the molybdenum compound being present or that a grease composition having superior properties when used for lubricating bearing of spindle motors employed in peripheral information devices would be arrived at if the molybdenum compounds were added thereto.

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This argument is not well taken. The examiner points out that claim 3 of the instant application does not include a molybdenum compound in the composition. If applicants urge this is in fact a critical feature of the instant invention, claim 3 will be subjected to a 35 U.S.C. 112 rejection. The recitation "additive" and "antioxidant" in the '465 application encompasses the organomolybdenum compounds of the instant claims. The application also claims the same utility, i.e. lubricant for a spindle motor for a hard disk drive.

Applicants allege patentability over Morway et al on the basis that the reference discloses an enumerable amount of structural isomers having from 8-20 carbon atoms and having varying properties of boiling points and viscosity ranges which could not be used for information devices as intended in the present application.

It is the examiner's position that the carbonates prepared by oxo synthesis are not the only carbonates taught. Note especially col 2 lines 1 to 41 as well as claims 1 and 6 where the radicals R and R¹ are not radicals of Oxo-alcohol but are of the same nature as in the instant claims. Morway provides for the presence of conventioned additives in the lubricant composition, including thickeners and antioxidants. The molybdenum compounds are shown by Doner and Tanaka to be conventional additives in grease compositions.

The examiner also takes the position that one of ordinary skill in the art would know that grease compositions are used to lubricate bearings and the manner of lubrication would be obvious so whether the grease was sealed or unsealed in the bearing would not lend patentability to the claimed invention.

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Applicants pointed to the Examples and comparative Examples to point out the clearly superior properties of the present invention over the grease compositions which fall within the disclosure of the prior art. It is the examiner's position that comparative Example 3 is the only example which would be a comparison with the closest prior art and in this Example, no molybdenum compound was used. The same components as in the invention Example 3 were used, so all of the results would be expected to be the same. The examiner does not understand why the mixing consistency and dropping points were different. Obviously some other factor is involved or accounts for the different fretting resistance rating. It is the examiner's position that the Examples are not a comparison of the closest prior art and do not show unexpected results.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication should be directed to J. Howard at telephone number (703) 308-2514.

JHoward:evh

8/20/01


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PRIMARY EXAMINER
GROUP 1100